

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFRY J. GRAINGER

Appeal 2007-0776
Application 09/996,338
Technology Center 3600

Decided: September 27, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jeffrey J. Grainger (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 4-9, 11-13, and 19-34, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is to a computer-implemented method of facilitating the preparation of intellectual property documents, such as patent applications, securing intellectual property rights and managing intellectual property assets (Specification 1:11-15). Claim 19, reproduced below, is representative of the subject matter on appeal.

19. A method of managing electronic documents related to a plurality of patent applications, the method comprising:

for a plurality of different and unrelated technology developers, allowing users from each such technology developer to create a plurality of invention disclosures for each respective technology developer;

receiving the plurality of invention disclosures from the users from each technology developer at a server system over a network and storing each invention disclosure in one of a plurality of collections of electronic documents and data in a computer-readable memory operatively coupled to the server system, wherein each collection is associated with one of the plurality of patent applications and assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection;

storing, in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents such that at least some users associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that users associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers;

maintaining and enforcing rights to electronic documents in the plurality of collections of electronic documents for users associated with a plurality of patent firms such that at least some users from selected ones of the patent firms have rights to view selected invention disclosures stored in the collections and selected electronic documents stored in the collection selected invention disclosure is stored in and create and modify patent applications prepared for the selected invention disclosures;

receiving any such created patent application at the server system and storing it in the collection of electronic documents the respective invention disclosure is stored in;

maintaining and enforcing rights to file patent applications in a patent office for users associated with the plurality of law firms such that only selected users from the law firms have rights to file patent applications in the patent office; and

electronically receiving a request from a user to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request;

wherein each user from the plurality of different and unrelated technology developers and each user from the plurality of patent law firms is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection; and

wherein when a user generates a request to perform an operation on an electronic document in a particular collection of electronic documents, in response to receiving the request, determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document assigned; (iii) one or more roles to which the user is assigned (iv) unit level access information for the particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned,

the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Takano	US 6,434,580 B1	Aug. 13, 2002
Serbinis	US 6,584,466 B1	Jun. 24, 2003

The Appellant seeks our review of the rejection of claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis. This issue turns on whether:

- 1) Takano and Serbinis, when considered collectively, teach or suggest all of the elements of the claimed invention;
- 2) The combined teachings of Takano and Serbinis would have led one having ordinary skill in the art to the claimed invention; and
- 3) The Appellant has shown that one having ordinary skill in the art at the time the invention was made would not have had a reasonable expectation of success in combining the teachings of Takano and Serbinis.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers connected to a communications network, such as the Internet (Takano, col. 1, ll. 13-18). In particular, Takano's system includes client computers 100 and 200 and a server computer 300, which are connected to one another via a communications network, such as the Internet (Takano, col. 5, ll. 46-51).
2. Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (Takano, col. 5, ll. 55-61).
3. Takano discloses that a person working in the company application processing department or an outside person at a law firm representing the company (collectively referred to hereafter as the patent attorney) uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (Takano, col. 6, ll. 5-13).
4. Takano describes that once the inventor has registered the draft data for the specification on the server computer 300, the patent attorney can

access the draft on client computer 200 in order to revise it (Takano, col. 8, ll. 7-11). Takano describes that the system may restrict the patent attorney's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (Takano, col. 8, ll. 14-18).

5. Similarly, Takano describes that after the patent attorney finishes revising the draft, the inventor can then review the revisions (Takano, col. 10, ll. 8-15). Takano again describes that the system may restrict the inventor's access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (Takano, col. 10, ll. 15-22).
6. As such, Takano imposes access controls on the information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information. The identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney).
7. Takano also discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component (Fig. 18) (element 205 (patent application document data transmitting means)) to file the application in the patent office.

8. In particular, Takano describes a sixth embodiment of the system (Takano, col. 16, l. 15 – col. 18, l. 18), which includes a client computer 500 to be used by the Patent Office to receive patent application filings transmitted from the patent attorney via client computer 200 (Takano, col. 16, ll. 45-50). As we found *supra*, Takano teaches that the DMS system can be configured so that the patent attorney may be allowed to access only those patent applications that pertain to a certain group, such as inventors belonging to a specific department (FF 4). As such, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such documents.
9. Takano further discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (Takano, col. 9, ll. 11-22).
10. Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by the field headings to complete the input fields via an invention report information screen (Takano, col. 7, ll. 11-26; Fig. 3).
11. Serbinis discloses an apparatus and methods for managing electronic documents over open networks, such as the Internet, to permit users to store, retrieve, and collaboratively manipulate files (Serbinis, col. 1, ll. 6-9). Serbinis discloses that the apparatus and method includes an Internet-based document management system (DMS) wherein an electronic

document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (Serbinis, col. 3, ll. 15-20).

12. The server is programmed to provide a plurality of document management services, including document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service (Serbinis, col. 4, ll. 18-23).
13. Serbinis describes that the server is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (Serbinis, col. 3, ll. 32-34).
14. Serbinis discloses that each user of the DMS system has access to one or more document groups, where each document group comprises a collection of document objects (Serbinis, col. 7, ll. 18-21). Each document stored in the DMS system also has an associated state, e.g., pending, active, archived, canceled, and deleted (Serbinis, col. 7, l. 63 – col. 8, l. 1). Serbinis discloses that certain users have access to particular document based on the state associated with the document. For example, document instances marked “active” are accessible by all Authorized Users, but document instances marked “archived” are accessible only to the document Originator (Serbinis, col. 8, ll. 10-17). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in

the role of the Originator, the user can access an archived document and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document.

15. Serbinis further describes that a document Originator, in using the DMS system, uploads and stores a previously-created document in the system and then defines one or more Authorized Users who may access the document (Serbinis, col. 8, l. 64 – col. 9, l. 3 and col. 9, ll. 19-22). The Originator also specifies the types of access that each Authorized User is to receive, e.g., retrieve, review, or modify (Serbinis, col. 9, ll. 22-28). In this example, if the Originator designates only one Authorized User, then that user's role is as the sole Authorized User, and the system imposes the use permissions (e.g., retrieve, review, or modify) for that document based on the type of access previously-defined by the Originator for the user role.
16. Serbinis further discloses that users are granted rights via the DMS authorization system, which defines the rights users have on particular document objects, document instances, and document groups (Serbinis, col. 12, ll. 24-27). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (Serbinis, col. 12, ll. 38-42). As such, Serbinis discloses another example of imposing use permissions based on the user's role

(e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document.

17. As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document.
18. Serbinis further discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (see Fig. 2, block 61).
19. Serbinis also discloses that the DMS system database includes user information tables 62 that include user group information, i.e., information on the group of users that the user is a part of, including the name of the group, the state of the group, the group's security information, and document rights for the group (Serbinis, col. 6, ll. 41-46 and Fig. 2, block 62).
20. As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator's list of Authorized Users for this document? (FF 15) Or is the user part of a group, and if so, what document rights are associated with that group? (FF 19)), (ii) a second group to which the electronic document is assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is

assigned (i.e., is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to the document in the role as an Originator? (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF18)).

21. Serbinis further suggests that information from its DMS system can be presented to the user on a web page via a web browser without the need for a specialized client application (Serbinis, col. 2, ll. 3-20).
22. Serbinis defines a “closed system” as “a closed client/server architecture network, such as a local area network or wide area network” and provides an example of an “open system” as one that makes electronic documents available via the Internet (Serbinis, col. 1, ll. 12-15 and col. 2, ll. 12-13).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ at 464 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739, 82 USPQ2d at 1395. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40, 82 USPQ2d at 1395. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740, 82 USPQ2d at 1395.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellant summarizes his arguments as follows:

Takano and Serbinis each fail (either individually or collectively) to teach or suggest each element of any pending claim. Further, the Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner. Finally, there would be no reasonable expectation of success in the proposed combination of Takano and Serbinis.

(Appeal Br. 8).¹ We address each of these arguments in turn.

¹ Only those arguments actually made by the Appellant have been considered in this decision. Arguments which the Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2006).

First Contention: Takano and Serbinis fail to teach or suggest each element of any pending claim.

The Appellant elaborates on his first contention by pointing to specific claim language in independent claims 19, 20, and 27, and in dependent claim 8, that he contends are neither taught nor suggested by Takano and Serbinis. In particular, the Appellant contends that the subject matter of claims 19, 20, and 27 is not obvious because “[n]either Takano nor Serbinis teach[es] the use permissions in user roles to determine whether a user can perform an operation on an electronic document” (Appeal Br. 10-12). We disagree.

Takano discloses a method and program for preparing patent specifications with inventors and those in charge of filing the patent applications using a plurality of computers 100, 200, and 300 connected to a communications network, such as the Internet (FF 1). Takano discloses that the inventor uses client computer 100 to prepare draft data on a specification for a patent application (FF 2), and that a patent attorney uses client computer 200 to revise the draft data provided by the inventor and prepare the final specification to be filed with the Patent Office (FF 3). Takano describes that the system may restrict the patent attorney’s access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to inventors belonging to a specific department (FF 4). Similarly, Takano describes that the system may restrict the inventor’s access to only that information from the server computer 300 that satisfies specific conditions, such as only that information pertaining to the inventor concerned (FF 5). As such, Takano imposes access controls on the

information stored on its server computer 300 depending on the group (e.g., department) from which the information came, or depending on the identity of the user (e.g., the patent attorney or inventor) attempting to access the information (FF 6). In this case, the identity of the user, as described in Takano, is the user's role (e.g., inventor or patent attorney) (FF 6).

Serbinis discloses further access controls within the context of a document management system. Serbinis discloses an apparatus and method for managing electronic documents using an Internet-based document management system (DMS) wherein an electronic document may be stored on an Internet-accessible server and accessed using a previously-known web browser, downloaded for review or manipulation, and then returned to the server for access by further users (FF 11) The server is programmed to provide a plurality of document management services and is also programmed to perform a security function, to verify or define a requestor's ability to access an electronic document (FF 12, 13).

Serbinis discloses that each user of the DMS system has access to one or more document groups and each document stored in the DMS system also has an associated state, such that certain users have access to particular documents based on the state associated with the document (FF 14). For example, document instances marked "active" are accessible by all Authorized Users, but document instances marked "archived" are accessible only to the document Originator (FF 14). As such, Serbinis discloses use permissions based on the user's role, e.g., if the user is in the role of the Originator, the user can access an archived document

and if the user is in the role of an Authorized User, the user is restricted from accessing the same archived document (FF 14).

Serbinis further describes that a document Originator defines one or more Authorized Users who may access the document and also specifies the types of access that each Authorized User is to receive, so that if the Originator designates only one Authorized User and that user's role is as the sole Authorized User, then the system imposes the use permissions based on the type of access previously-defined by the Originator for the Authorized User role (FF 15).

Serbinis further discloses that users are granted rights based on particular document objects, document instances, and document groups (FF 16). For example, for a particular document uploaded to the system, the Originator may have owner rights, retrieval rights, viewing rights, and the right to revoke access by a previously-specified Authorized User, while an Authorized User may have only viewing and retrieval rights (FF 16). As such, Serbinis discloses another example of imposing use permissions based on the user's role (e.g., Originator versus Authorized User) to determine whether the user can perform an operation on an electronic document, such as changing the list of Authorized Users associated with the electronic document (FF 16).

As such, we find that Serbinis discloses several examples of how the DMS system imposes use permissions in user roles to determine whether a user can perform an operation on an electronic document (FF 17). Accordingly, we find the Appellant's argument that neither Takano nor Serbinis discloses use permissions in user roles to be without merit.

The Appellant further contends that “[n]either Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, and (iii) permissions associated with user roles to determine whether a user can perform an operation on an electronic document, as recited by claim 27” (Appeal Br. 13). The Appellant similarly contends that “Serbinis and Takano each fail (either individually or collectively) to teach or suggest using this combination, along with (iv) unit-level access information, to make such a determination, as recited by claims 19 and 20” (*Id.*). We disagree.

Serbinis, for example, discloses that the DMS system database includes document information, including information on rights for each document and rights for a group of documents (FF 18). Serbinis also discloses that the DMS database includes user information tables that include user group information, i.e., information on the group of users that the user is a part of, including the group’s security information, and document rights for the group (FF 19). Further, as found *supra*, the DMS system of Serbinis maintains a list of Authorized Users designated by an Originator (FF 15), information on the state of each document which dictates which users have access to the document (FF 14), and information about the role of a user as Originator or Authorized User (FF 16).

As such Serbinis discloses that the DMS system, when receiving a request to access a document, determines (i) a first group to which the user is assigned (i.e., is the user on the Originator’s list of Authorized Users for this document? (FF 15) Or, is the user part of a group, and if so, what document rights are associated with that group (FF 19)), (ii) a second group to which the electronic document is

assigned (i.e., is the document assigned to the group of archived documents accessible only by the Originator? (FF 14)), (iii) one or more roles to which the user is assigned (Is the user making the request for the archived document assigned the role of the document Originator? (FF 14) Or, does the user have owner rights to this document in the role as an Originator (FF 16)), and (iv) unit level access information for the document (i.e., Is the user permitted access to this group of documents and further is the user permitted access to the particular requested document with the group (FF 18)). (FF 20.) Accordingly, we find the Appellant's argument that neither Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, (iii) permissions associated with user roles, and (iv) unit-level access information to determine whether a user can perform an operation on an electronic document to be without merit.

The Appellant further contends that the subject matter of claims 19 and 20 is not obvious because Serbinis and Takano do not teach or suggest "determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request" (claim 19) or "a patent application filing component" (claim 20) (Appeal Br. 14-15). We find the Appellant's arguments unpersuasive.

Takano discloses receiving a request from a user to file a patent application, determining if the system has rights to file the application, and, if so, using a patent application filing component to file the application in the patent office (FF 7). In particular, as described in Takano, the DMS system checks to see if the patent attorney has rights to access documents before granting the user access to such

documents, and thus the system allows only those patent attorneys with the appropriate rights to file patent applications at the patent office (FF 8).

The Appellant further contends that the subject matter of dependent claim 8 is not obvious because neither of the cited references teaches or suggests that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page (Appeal Br. 15).

Takano discloses a template downloading means 105 on client computer 100 that reads in document data in a specification form for a patent application so that the inventor has to fill in the blanks in the template to complete the draft application (FF 9). Takano further discloses that the inventor completes an invention report to accompany the patent application draft, wherein the inventor is prompted by field headings to complete the input fields via an invention report information screen (FF 10). The Appellant contends that “[p]roviding a template for a specification form is in no way similar to presenting questions to be answered by an inventor.” We fail to see a patentable difference between the prompts or input fields described in Takano and a list of questions posed to the user. In either case, whether the prompts are in the form of phrases, statements, or questions, the words prompt the user to enter information. Although Takano discloses that communications between the inventor and the server occur via the Internet, Takano does not explicitly state that it uses web pages for this communication.

Serbinis, however, clearly teaches that information from its document management system can be presented to the user on a web page via a web browser without the need for a specialized client application (FF 21). We find that it would

have been obvious to one having ordinary skill in the art at the time the invention was made to have presented Takano's patent specification templates and invention report information screens to users via a web page because both Takano and Serbinis disclose access via the Internet and Serbinis suggests using web pages to display information to the user to eliminate the need for a specialized client application. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 ("if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.") As such, we find the Appellant's argument that neither Takano nor Serbinis discloses that the invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a web page to be unpersuasive.

Second Contention: The Final Office Action does not make the requisite showing of a teaching or suggestion to combine Takano and Serbinis in the contemplated manner.

The Appellant elaborates on his second contention by arguing that because Takano is directed to a closed system and thus does not contemplate a system with multiple, independent entities, Takano does not have any need for the access control protocols of Serbinis (Appeal Br. 17). The Appellant further argues that the Examiner failed to identify how the teachings of Serbinis might provide additional benefit in the areas of collaborative file sharing and workflow,

document delivery, and document distribution over what Takano already provides (*Id.*).

As we found *supra*, Takano discloses that its DMS system is designed to be used via the Internet (FF 1). As such, we find no basis for the Appellant's contention that Takano is directed to a closed system. Serbinis defines a "closed system" as "a closed client/server architecture network, such as a local area network or wide area network" and provides an example of an "open system" as one that makes electronic documents available via the Internet (FF 22). As such, both Takano and Serbinis envision document management systems that use open systems (e.g., accessible via the Internet) to make documents available to users. Further, we disagree with the Appellant's contention that Takano does not have any need for access control protocols. On the contrary, as we found *supra*, Takano implements access controls to restrict inventor and patent attorney access to information on the server computer 300 (FF 4, 5).

Further, the Appellant's argument that the Examiner fails to identify how the teachings of Serbinis might provide additional benefit to Takano misses the mark. As demonstrated by our findings of fact, Serbinis clearly discloses improvements to the access control restrictions in a document management system. These improvements add additional layers of security to the documents. Takano deals with the highly confidential, proprietary, and privileged communications between attorneys and clients regarding inventions and patent applications. It would have been obvious to one having ordinary skill in the art to have implemented the improved access control restrictions, as taught by Serbinis, in the system of

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Takano, to better protect access to highly sensitive patent application information and to better ensure control over the disclosure of the information contained therein. *See KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396 (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”)

Third Contention: There would be no reasonable expectation of success in the proposed combination of Takano and Serbinis

The Appellant elaborates on his third contention by arguing that because the system of Takano uses specialized software on the client and server, if a user attempted to connect to the DMS of Serbinis with the client software of Takano, there would be no reasonable expectation that such a connection would be successful (Appeal Br. 19). In particular, the Appellant asserts that “nothing in Takano teaches or suggests that the client software of Takano might be configured to interoperate generally with a web server using HTTP and servlets” (*Id.*). The Appellant’s argument seems to amount to a contention that because the system of Takano would require modification, there would have been no reasonable expectation of success. This is not the test for reasonable expectation of success and the law on motivation to combine does not require an explicit teaching or suggestion in the reference for the modification. *See KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396 (“the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the

inferences and creative steps that a person of ordinary skill in the art would employ.”) Additionally, the Appellant has not demonstrated unpredictability of this field of art at the time of the invention or even that the modifications to Takano would have been beyond the skill level of one of ordinary skill in the art at the time of the invention. As noted by the Examiner (Answer 48), the Appellant has provided no evidence to support his assertion that a person having ordinary skill in the art would have had no reasonable expectation of success in the combination of Takano and Serbinis. Without more, we find the Appellant’s argument unpersuasive. As such, we find that a prima facie case of obviousness of the claimed invention exists in view of the combined teachings of Takano and Serbinis, and the Appellant’s arguments have failed to persuade otherwise.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 4-9, 11-13, and 19-34 under 35 U.S.C. § 103(a) as unpatentable over Takano and Serbinis.

DECISION

The decision of the Examiner to reject claims 4-9, 11-13, and 19-34 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

jlb

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